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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,035	07/12/2007	Lutz May	40124/09301- (N 7361/KK)	9430
30636 7590 09/13/2011 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			EXAMINER SORKIN, DAVID L	
			ART UNIT 1774	PAPER NUMBER
			MAIL DATE 09/13/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,035	<b>Applicant(s)</b> MAY, LUTZ	
	<b>Examiner</b> DAVID SORKIN	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) ☒ Claim(s) 1-12, 14-18, 20, 21 and 24-44 is/are pending in the application.
- 5a) Of the above claim(s) 40-44 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-12, 14-18, 20, 21 and 24-39 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 20 June 2011 is acknowledged. While it is true that the groups of claims share features, there is no shared *inventive* feature. The features that are shared are known in the art, as seen herein below.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12, 14-18, 20, 21 and 24-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The triple recitation of "a reciprocating object" in claim 34, makes subsequent references to "the reciprocating object" unclear as to which reciprocating object is being referenced.

4. Claims 34-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The triple recitation of "a reciprocating object" in claim 34, makes subsequent references to "the reciprocating object" unclear as to which reciprocating object is being referenced.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 7-12, 14, 15, 24, 25 and 33-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Hume (US 4,854,721). Regarding claim 1 and 34, Hume discloses an array comprising a reciprocating object (24); and a position sensor device for determining a position of the reciprocating object, wherein the position sensor device includes at least one magnetically encoded region (26) fixed on a reciprocating object; a least one magnetic field detector (58, 60); a position determining unit (see Fig. 22). Regarding claim 2, the at least one magnetically encoded region is a permanent magnetic region (see col. 6, line 20). Regarding claim 3, the region is longitudinally magnetized (see Fig. 1). Regarding claim 4, the region is circumferentially magnetized (see Fig. 1). Regarding claims 7-12, "The patentability of a product does not depend on its method of production." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Regarding claim 14, the region is a magnetic element (26) attached to the surface of the reciprocating object. Regarding claim 15, the magnetic field detector comprises a Hall-effect probe (see col. 6, line 22). Regarding claims 24 and 25, plural detectors (58, 60 ) are disclosed. Regarding claim 33, the reciprocating object is not a

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required element of the claimed structure. Regarding claim 35, the reciprocating object is a shaft (24). Regarding claim 36, the magnetically encoded region is provided along the length of the reciprocating object (see Fig. 1). Given that at least one of the three recited reciprocating objects is not a required element of the claimed structure, it is considered that claims 37 and 38 are anticipated. Regarding claim 39, a control unit is disclosed (See Fig. 22).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6, 16-18, 20, 21, 26-32, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hume (US 4,854,721). One magnetic region, rather than a plurality, is disclosed. However, see *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) regarding the obviousness of duplicating parts. Similarly, only two detectors are disclosed, but further duplicating detectors would have also been obvious.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID SORKIN whose telephone number is (571)272-1148. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter D. Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID L. SORKIN/  
Primary Examiner, Art Unit 1774